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ATLANTA GA 30309

MAILED
JUL 26 2010
OFFICE OF PETITIONS

In re Patent No. 7549420 : DECISION ON REQUEST
Martinez et al. : FOR
Issue Date: 06/23/2009 : RECONSIDERATION OF
Application No. 10/517,419 : PATENT TERM ADJUSTMENT
Filed: 12/08/2004 : and
Atty Docket No. : NOTICE OF INTENT TO ISSUE
41052/309048 : CERTIFICATE OF CORRECTION

This is a decision on the petition filed on January 6, 2009, which is being treated as a request for reconsideration under 37 CFR 1.705(d) requesting that the patent term adjustment be recalculated. The petition is being treated as a petition requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand one hundred (1100) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand one hundred (1100) days is **GRANTED to the extent indicated herein**.

On October 7, 2008, the Office mailed the Determination of Patent Term Adjustment Under 35 U.S.C. 154(b), stating that the Patent Term Adjustment to date is 539 days.

On January 6, 2009, the present petition was timely filed.¹ On June 23, 2009, prior to the issuance of a decision on the present petition, the above-identified application issued as U.S. Patent No. 7,549,420, with a revised patent term adjustment of 587 days. As the patent has now issued, the petition will be treated as a petition under 37 CFR 1.705(d).

Patentees state that the patent term adjustment is thought to be longer than appropriate. Specifically patentees state that the fulfillment date under 35 U.S.C. 371(c) should be August 9, 2005, not December 8, 2004, because an executed declaration was not filed until August 9, 2005.

A review of the official file reveals that an executed oath or declaration was filed on December 8, 2004. The declaration was submitted in the international phase under PCT Rule 4.17 and is in

¹ A review of Office records reveals the issue fee was paid on January 6, 2009.

French. The declaration filed on December 8, 2004 is acceptable. Accordingly, the date of fulfillment under 35 U.S.C. 371(c) is December 8, 2004, and no change to the patent term adjustment based on the 35 U.S.C. 371(c) date is warranted.

Patentees further state that the recalculation should include the period under 35 U.S.C. 154(b)(B).

With regards to the "B" delay, 37 CFR 1.702(b) states that the period of adjustment under 35 U.S.C. 154(b) is the period beginning three years after the date on which an application was filed under 35 U.S.C. 111(a), or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application. This application was filed pursuant to 35 U.S.C. 371(b), not under 35 U.S.C. 111(a), and the national stage commenced on December 10, 2004. The period of delay is 561 days, counting the number of days beginning on December 11, 2007, the day after the date three years after the national stage commenced, and ending on June 23, 2009, the date the patent issued. See 1.703(b). Considering the overlapping period of 48 days, from May 7, 2009, the day after the date four months after the date the issue fee was paid until June 23, 2009, the date the patent issued, the non-overlapping period of adjustment is 513 (561 – 48) days.

The patent term adjustment is updated to one thousand one hundred (1100) days (677 days of Office delay + 561 days of Three Years Delay – 48 overlapping days – 90 days of applicant delay).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office thanks Patentees for their good faith and candor in bringing this matter to the attention of the Office.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand one hundred (1100) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,549,420 B2

DATED : Jun. 23, 2009

DRAFT

INVENTOR(S) : Martinez et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 587 days.

Delete the phrase "by 587 days" and insert -- by 1100 days--